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REMARKS

Claims 1-17, 19, 20, and 22-32 are currently pending. Claims 1, 10-17, 28-30, and 32 have been amended. The amendment of these claims is supported by Applicant's original disclosure, including page 11, lines 23-24, page 12, lines 17-21, and page 13, lines 17-21. It is respectfully submitted that no new matter has been added.

Allowance of Claims 20 and 22-27 and indication-of-patentable-subject-matter in Claims 6, 14, and 31

The Patent Office is thanked for its allowance of claims 20 and 22-27 and its indication that claims 6, 14, and 31 recite patentable subject matter. However, applicant believes that all pending claims are allowable.

Rejections under 35 U.S.C. 103(a)

Applicant's claimed invention relates to a method for relating a plurality of system identifications (SIDs) in a mobile device. The method includes the steps of identifying a plurality of SIDs having a common spatial characteristic, storing the identified plurality of SIDs, comparing a SID received from a wireless service provider to the stored plurality of SIDs and, upon any one of the plurality of stored SIDs matching the received SID, declaring the wireless service provider as being a Home service provider. Alternatively, or in conjunction with comparing received SIDs for the case where none of the plurality of stored SIDs matches the received SID, Applicant's claimed invention further compares a received System Operator Code (SOC) to stored SOC's, including at least one of a Home SOC, a Partner SOC, a Favored SOC and a Forbidden SOC.

The problems addressed in Applicant's invention and the prior art are quite different, as Applicant's goal is to prevent a mobile station from roaming (and thereby avoid additional roaming costs) as much as possible, when the mobile station travels within its home area (e.g. home town). An aspect of Applicant's claims invention provides "declaring the wireless service provider as being a home service provider for the mobile station," such that the mobile station is not considered to be roaming.

Without admitting implicitly or explicitly to amend, to advance prosecution, the claims

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have been amended to recite “declaring the wireless service provider as being a home service provider for the mobile station such that the mobile station is assumed to not be roaming and roaming charges are avoided.”

The Patent Office rejected claims 1 and 32 under 35 U.S.C. 103(a) as being unpatentable over Seazholtz, U.S. Patent No. 5,920,821, in view of La Medica, U.S. Patent No. 6,625,451.

Claim 1 recites

A method comprising: storing a system identification that identifies a home service provider for a mobile station; identifying a plurality of system identifications having a common spatial characteristic; storing the identified plurality of system identifications in a memory that is accessible by a mobile station; comparing a system identification received from a wireless service provider to the stored plurality of system identifications; and upon any one of the plurality of stored system identifications matching the received system identification, declaring the wireless service provider as being a home service provider for the mobile station such that the mobile station is assumed to not be roaming and roaming charges are avoided.

Seazholtz (US5920821) describes a system where a roaming subscriber scans a channel for a list of SIDs for each of a plurality of available frequency bands. Then a comparison is made with a stored list of preferred SIDs and a single SID is then selected. After the selection the terminal establishes a carrier corresponding to the selected SID.

However in Applicant’s claimed invention the plurality of SIDs in the memory could all represent a potential home service provider, since whenever a received SID matches a SID in the stored list, the service provider is declared as a home service provider for the mobile station. Furthermore it is explicitly said in page 9, lines 30-34, of Applicant’s application that “If the received SID matches any of the stored SIDs in the Cousin SID list 200, the mobile station 10, when operating in the prepaid mode, makes the determination that the category of the associated service provider is a Home service provider, and that the mobile station 10 is not roaming”.

Therefore, Seazholtz fails to teach the subject matter as claimed, and fails to declare the service provider associated with the selected SID as Home service provider. By definition, in Applicant’s claimed invention, the mobile station is not roaming. When a match is found, the subscriber is a non-roaming subscriber.

The Patent Office asserted on page 4, lines 3-8, of the Office Action dated September 28, 2009 as follows: "Seazholtz does not explicitly show that at least one memory, the at least one memory comprising a location for storing a system identification that identifies a home service provider for the apparatus, wherein said wireless controller is configured to identify a plurality of system identifications having a common spatial characteristic configured to store the identified plurality of system identifications having the common spatial characteristic in the at least one memory."

Then, the Patent Office asserted as follows: "In the same field of endeavor, La Medica teaches at least one memory, the at least one memory comprising a location for storing a system identification that identifies a home service provider for the apparatus, wherein said wireless controller is configured to identify a plurality of system identifications having a common spatial characteristic (col. 15 line 53 through col. 16 line 4); configured to store the identified plurality of system identifications having the common spatial characteristic in the at least one memory (col. 15 line 53 through col. 16 line 4)." This passage of La Medica is reproduced below as follows:

The subscriber station 3 also maintains a stored list of 'preferred' systems, as a preferred roaming list (PRL). The 'preferred' systems are foreign systems 21 that the subscriber station may use as part of the one-rate service, because they are part of the operator's wide area system or because the home operator has established favorable roaming agreements with the local operators. For each of the 'preferred' systems, the list contains a system identification (SID) as well as acquisition parameters (band, frequency, mode, etc.). Some geographic regions may receive service from two or more 'preferred' systems. For systems that cover such a common geographical region, the stored PRL/SID list ranks the systems in the area. Such systems are prioritized or ranked based on desirability. For the one-rate service, the systems providing such overlapping service are typically ranked in terms of best cost from the service provider's perspective. In a preferred embodiment of the mobile station, the PRL has a minimum capacity of 256 System ID's per NAM.

La Medica does not teach or suggest the claimed subject matter of "declaring the wireless service provider as being a home service provider for the mobile station such that the mobile station is assumed to not be roaming and roaming charges are avoided" and, thus, does not remedy the deficiency in Seazholtz.

In that neither Seazholtz nor La Medica teaches or suggest "declaring the wireless service provider as being a home service provider for the mobile station such that the mobile station is

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assumed to not be roaming and roaming charges are avoided,” any combination of Seazholtz and La Medica would fail to teach or suggest this claimed subject matter.

Thus, claims 1 and 32 are allowable over Seazholtz in view of La Medica.

The Patent Office rejected claims 4, 7, 9, 10, 12, 15, 17, and 28 under 35 U.S.C. 103(a) as being unpatentable over Seazholtz in view of La Medica, and further in view of McGregor, U.S. Published Patent Application No. 2001/0000777.

As discussed above, Seazholtz in view of La Medica does not make obvious claim 1 since Seazholtz in view of La Medica does not disclose or make obvious declaring a wireless service provider as being a home service provider or home category service provider.

Claim 10 recites

A mobile station comprising: a processor configured to access at least one memory and that is responsive to a received system identification for comparing received system identification to system identifications in a list of system identifications and, upon any one of the plurality of system identifications matching the received system identification, declaring a wireless service provider that transmitted the system identification as being a home service provider for the mobile station such that the mobile station is assumed to not be roaming and roaming charges are avoided, wherein the mobile station associated with a prepaid service provider comprises the at least one memory storing the system identification that identifies the home service provider for the mobile station and a list containing a plurality of other system identifications having a common spatial characteristic.

Similar to the discussion regarding claim 1, neither Seazholtz nor La Medica discloses or suggests claim 10’s “declaring a wireless service provider that transmitted the system identification as being a home service provider for the mobile station such that the mobile station is assumed to not be roaming and roaming charges are avoided.”

McGregor, which discloses a home SID and a prepaid mode, does not remedy the deficiency of Seazholtz and/or La Medica.

Claim 17 recites

An apparatus, comprising: a controller; a wireless transceiver; and at least

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one memory, the at least one memory comprising a location for storing a home system identification and other locations configured to store a plurality of cousin system identifications, wherein said controller is configured to declare a system identification received through said wireless controller to be a home service provider if the received system identification matches the stored home system identification or any one of the plurality of stored cousin system identifications such that the apparatus is then considered to be non-roaming and roaming charges are avoided, wherein the at least one memory is configured to store the cousin system identifications under the direction of a prepaid service provider, and the cousin system identifications correspond to system identifications associated with one or more service providers that service a predetermined geographical area that is defined to be a non-roaming area of a customer of the prepaid service provider, wherein the home system identification is configured to be stored in at least one memory without the direction of a prepaid service provider.

The Patent Office has not provided a teaching or suggestion that the previously claimed subject matter of the cousin system identifications are stored into said at least one memory under the direction of a prepaid service provider and the home system identification is stored in at least one memory without the direction of a prepaid service provider, recited as “the cousin system identifications are stored into said at least one memory under the direction of a prepaid service provider” and “the home system identification is stored in at least one memory without the direction of a prepaid service provider.”

Neither Seazholtz nor La Medica disclose or suggest “the cousin system identifications are stored into said at least one memory under the direction of a prepaid service provider” and “the home system identification is stored in at least one memory without the direction of a prepaid service provider.”

Seazholtz, in column 9, lines 40-56, discloses as follows:

Another aspect of the present invention includes a system for downloading data to radio telephone subscriber units that includes control means for updating at least one data list to be downloaded to the radio telephone subscriber units and generating a version number corresponding to a most-current data list. The system includes means for broadcasting the version number to the radio telephone subscriber units on a CDPD frequency. Each of the participating radio telephone subscriber units includes means for receiving the version number and means for

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comparing the received version number to a version number previously stored in that radio telephone subscriber unit. Each of the radio telephone subscriber units also includes means for initiating via a CDPD channel a download of the data list based upon a comparison of the version numbers.

Seazholtz in column 9, lines 40-56 does not disclose cousin SIDs.

McGregor on page 12, in claim 25, discloses software but does not disclose “the cousin system identifications are stored into said at least one memory under the direction of a prepaid service provider” and “the home system identification is stored in at least one memory without the direction of a prepaid service provider.”

Barring disclosure of such subject matter by Seazholtz, La Medica, and McGregor, claim 17 is allowable over these three references, alone or in combination.

Because dependent claims 4, 7, 9, 12, 15, and 28 depend from either allowable claim 1 or allowable claim 10, these claims are allowable.

Thus, claims 4, 7, 9, 10, 12, 15, 17, and 28 are allowable over Seazholtz, La Medica, and/or McGregor.

The Patent Office rejected claims 2 and 3 under 35 U.S.C. 103(a) as being unpatentable over Seazholtz in view of La Medica, and further in view of Mizikovsky, U.S. Patent No. 5,983,115.

As discussed above, Seazholtz in view of La Medica does not make obvious claim 1 and does not disclose or make obvious “declaring the wireless service provider as being a home service provider for the mobile station such that the mobile station is assumed to not be roaming and roaming charges are avoided.”

Mizikovsky discloses (abstract) a communication device that locates a wireless service provider in a multi-service provider environment using a stored list of preferred service providers. The list has a plurality of uniquely identified sublists, each sublist is associated with a different geographic area and identifies a more preferred service provider and a less preferred service provider. Mizikovsky discloses (col. 8, lines 36-41) the mobile communication device

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registers with the best stored SOC or SID, that is, a SOC or SID that has at least been associated with a preferred service provider in which the best service provider is identified by comparing the stored SOC or SIDs with the list of preferred SOC or SIDs. Mizikovsky seeks to determine if a received SID or SOC is an optimal, preferred, or prohibited service provider (col. 5, lines 57-67) and does not appear to disclose or suggest assigning a home service provider (e.g., col. 3, lines 10-18).

In contrast, base claim 1 recites that if a received SID matches one of a plurality of SIDs, then the service provider corresponding to the matched SID from the plurality of SIDs is declared to be a home service provider for the mobile station.

Because none of Seazholtz, La Medica, and Mizikovsky teach or suggest “declaring the wireless service provider as being a home service provider for the mobile station such that the mobile station is assumed to not be roaming and roaming charges are avoided.” no purported combination of these three references would teach or suggest this claimed subject matter.

Thus, claims 2 and 3, because they depend from claim 1, are not made obvious by Seazholtz, La Medica, and/or Mizikovsky.

The Patent Office rejected claims 5, 8, and 19 under 35 U.S.C. 103(a) over Seazholtz, in view of La Medica and further in view of Bamburak, U.S. Patent No. 6,807,418.

Bamburak appears to be directed to finding an optimal service provider and not a home service provider (col. 3, lines 49-52). In Bamburak, the SOC or SID of a service provider is checked to determine if the SOC or SID corresponds to an optimal service provider (col. 5, lines 25-28) via a list of a optimal SOC or SIDs (col. 6, lines 28-30). Claims 1 and 17 recite that if a received SID matches one of a plurality of SIDs, then the service provider corresponding to the matched SID from the plurality of SIDs is declared to be a home service provider for the mobile station.

Like Seazholtz and/or La Medica, Bamburak does not appear to disclose or suggest the claimed subject matter of “declaring the wireless service provider as being a home service provider for the mobile station such that the mobile station is assumed to not be roaming and roaming charges are avoided.”

Because none of these three references disclose or suggest this claimed subject matter, no

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purported combination of these three references would disclose or suggest this claimed subject matter.

Thus, claims 5, 8, and 19 are not made obvious by Seazholtz in view of La Medica and Bamburak.

The Patent Office rejected claim 11 under 35 U.S.C. 103(a) as being unpatentable over Seazholtz in view of La Medica and McGregor, and further in view of Mizikovsky, U.S. Patent No. 5,983,115.

As discussed above, Seazholtz in view of La Medica and McGregor does not make obvious claim 10 and does not disclose or make obvious declaring a wireless service provider as being a home service provider or home category service provider.

Mizikovsky discloses (col. 8, lines 36-41) the mobile communication device registers with the best stored SOC or SID, that is, an SOC or SID that has at least been associated with a preferred service provider in which the best service provider is identified by comparing the stored SOC or SID with the list of preferred SOC or SID. Mizikovsky seeks to determine if a received SID or SOC is an optimal, preferred, or prohibited service provider (col. 5, lines 57-67) and does not appear to disclose or suggest assigning a home service provider (e.g., col. 3, lines 10-18). In contrast, the claimed invention in claim 10 recites that if a received SID matches one of a plurality of SIDs, then the service provider corresponding to the matched SID from the plurality of SIDs is declared to be a home service provider for the mobile station.

It does not appear that Seazholtz, La Medica, McGregor, or Mizikovsky discloses or suggests “declaring a wireless service provider that transmitted the system identification as being a home service provider for the mobile station such that the mobile station is assumed to not be roaming and roaming charges are avoided,” as is recited in claim 10.

Thus, claim 11 is allowable over Seazholtz, La Medica, McGregor, and/or Mizikovsky.

The Patent Office rejected claims 13 and 16 under 35 U.S.C. 103(a) over Seazholtz, La Medica, and McGregor, and further in view of Bamburak.

As discussed above, none of Seazholtz, La Medica, McGregor, or Bamburak discloses or suggests “declaring a wireless service provider that transmitted the system identification as being a home service provider for the mobile station such that the mobile station is assumed to not be

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roaming and roaming charges are avoided.”

Thus, claims 13 and 16 are allowable over the prior art of record.

The Patent Office rejected claims 29 and 30 under 35 U.S.C. 103(a) over Seazholtz in view of La Medica and further in view of Osmani, U.S. Patent No. 5,815,807.

Osmani discloses (column 1, lines 42-49) “Billing services for radiotelephone subscriber units include prepaid short term billing structures such as calling cards and debit cards and postpaid periodic billing structures. Cellular communication systems are owned and operated for profit by communications companies who typically sell use of the system based on the amount of time spent by the user on the system and the distance involved between the communicating locations. Users may lease or buy cellular phones in order to use them on the system.”

As discussed above, Seazholtz in view of La Medica does not make obvious claim 10 and does not disclose or make obvious declaring “declaring a wireless service provider that transmitted the system identification as being a home service provider for the mobile station such that the mobile station is assumed to not be roaming and roaming charges are avoided.” Osmani does not remedy the deficiency of Seazholtz in view of La Medica.

Base claim 10 is therefore not made obvious by any purported combination of Seazholtz, La Medica, and Osmani.

Thus, claims 29 and 30, which depend from base claim 10, are allowable over the prior art of record.

The Patent Office is respectfully requested to reconsider and remove the rejections of the claims 1-17, 19, and 28-30 under 35 U.S.C. 103(a) based on Seazholtz, La Medica, McGregor, Mizikovsky, Bamburak, and/ or Osmani, and to allow all of the pending claims 1-17, 19, 20, and 22-32 as now presented for examination. An early notification of the allowability of claims 1-17, 19, 20, and 22-32 is earnestly solicited.

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